

Appl. No. : 10/069,429
Filed : June 10, 2002

REMARKS

Claim 1 has been amended to clarify the invention. Support for the amendments to Claim 1 can be found in paragraphs [0029] through [0032] of the specification, for example. Claim 2 has been canceled without prejudice, and accordingly, Claims 3, 4, 5, and 9 have been amended to change their dependency. Claims 7 and 14 have been amended to correct clerical errors. Claims 20-26 have been added. Support for Claim 20 can be found in paragraph [0036] of the specification, for example. Support for Claims 21-22 can be found in paragraph [0049] of the specification, for example. Support for Claims 23-26 can be found in the original claims, for example. The amendments do not constitute the addition of any new matter to the specification. Applicant respectfully requests entry of the amendments and reconsideration of the application in view of the amendments and the following remarks.

Rejection Under 35 U.S.C. § 112

Claims 7 and 14 have been rejected under 35 U.S.C. § 112, second paragraph as being indefinite due to clerical errors. The errors have been corrected as the Examiner suggested, thereby obviating this rejection.

Rejection Under 35 U.S.C. § 102

Claims 1, 2, 4, and 9 have been rejected under 35 U.S.C. § 102(b) as being anticipated by JP11-131391 (Tokushu).

The Examiner asserts that Tokushu discloses a coating layer comprising colloidal silica and an inorganic pigment. However, in Tokushu, a plastic pigment is essential which is organic particles of a polymer compound (paragraph [0011]). In contrast, in Claim 1 as amended herein, the pigment consists of an inorganic pigment. Thus, Claim 1 could not be anticipated by Tokushu. Claim 2 has been canceled. Claims 4 and 9 are dependent on Claim 1, and at least for the reason, these claims also could not be anticipated by Tokushu.

Applicant respectfully requests withdrawal of this rejection.

Rejection Under 35 U.S.C. § 103

Claims 1-19 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over US Patent 6,420,039B1 (Field).

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The Examiner asserts that Field discloses a coating comprising colloidal silica, binder resin, sodium salt, and pigments. However, in Field, a coating is an aqueous dispersion of cationic silica, wherein the mean diameter of the silica particles is from about 100 nm to about 1 μ m, and the pH of the dispersion is from about 2 to about 6 (column 2). In Field, the pH must be in the above range (or an even narrower range of 3-4, column 1, line 56) to adjust the viscosity. This is because the purpose of Field is to provide a glossy coating used for a recording medium for, e.g., ink jet, and surface tack and curling are not considered.

In contrast, in Claim 1 as amended herein, the inorganic surface preparation agent is an alkaline dispersion liquid comprising silica sol or colloidal silica containing ultra-fine silica particles having a particle size of less than 100 nm. In the above, the silica particles penetrate into a paper layer and strongly adheres to pulp, thereby preventing surface tack and curling caused by dampening solution at offset printing (e.g., paragraph [0029]). These problems are unique to offset paper for offset printing and irrelevant to a recording medium of Field. Thus, Claim 1 as amended herein could not be obvious over Field. The remaining claims are dependent ultimately on Claim 1, and at least for the reason, these claims also could not be obvious over Field. Applicant respectfully requests withdrawal of this rejection.

New Claims

New Claim 20 is dependent ultimately on Claim 1 and is further distinct from the prior art because no prior art teaches or even suggests a colloidal solution of 10-20 nm using sodium silicate reacted with an inorganic acid, wherein the inorganic salt is a product of the reaction.

New Claims 21 and 22 are dependent on Claim 1 and are further distinct from the prior art because no prior art teaches or even suggests the coating layer applied in an amount of 0.1-1.0 g/m² per both sides or 0.3-1.0 g/m² per both sides.

New Claims 23-26 are distinct from the prior art because no prior art teaches or even suggests the inorganic surface preparation agent comprising (i) silica sol or colloidal silica and (ii) an inorganic salt selected from the group consisting of sodium sulfate and sodium nitrate.

Thus, it is respectfully submitted that these claims are patentable.

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CONCLUSION

In light of the Applicant's foregoing Remarks, it is respectfully submitted that the present application is in condition for allowance. Should the Examiner have any remaining concerns which might prevent the prompt allowance of the application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410. A duplicate copy of this sheet is enclosed.

Respectfully submitted,
KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: August 21, 2003

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